

## **REMARKS**

Claims 1-20 are pending in the current application. Applicants have amended independent claim 1. Support for the amendments is found, for example, from Page 9, Paragraph 1 to Page 10, Paragraph 1 of the specification and Figure 5 of the drawings. No new matter has been introduced by way of this amendment.

Initially, Applicants would like to thank Examiner Velez for indicating that claims 11-20 contain allowable subject matter and would be allowable if rewritten in an independent form including all of the limitations of the base claim and any intervening claims. In this regard, Applicants have amended claim 11 to independent format by incorporating the limitations of claims 1 and 10 into claim 11. Applicants believe the amendment has placed claims 11-20 in condition for allowance.

The Examiner has rejected 1, 4, 6-7 and 9 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 6,344,752 to Hagihara et al., (hereinafter "Hagihara"). Applicants respectfully submit that the rejection is overcome in light of the amendment made to claim 1 and the following remarks.

To maintain a claim rejection under 35 U.S.C. §102, a reference must disclose each and every element of the claim, either expressly or inherently. Hagihara fails to do so.

Claim 1, as amended, recites an inspection probe for inspecting electrical properties of a semiconductor device. The inspection probe includes a base member, wiring layers mounted on an outer surface of the base member, probe pins electrically connected to and contacting the wiring layers, first metal layers provided to the tips of the probe pins, and second metal layers formed on the wiring layers. The second metal layers are made of a material different from that of the probe pins. The first metal layers and the second metal layers are physically separated from each other

by the probe pins. With the wiring layers mounted on an outer surface of the base member and probed pins physically connected to the wiring layers, it is feasible to form the wiring layers and probe pins simultaneously through an electroplating process, which in turn saves costs and steps of manufacturing an inspection probe.

As depicted in Figure 2, Hagihara discloses a probing contactor (1) including a substrate (2), a connection conductor (6) formed within the substrate, an electrode (3) formed on the substrate to entirely cover the connection conductor (6), and a probe terminal (8) formed on the electrode (3). Specifically, the connection conductor (6), which is interpreted by the Examiner as a disclosure of wiring layers recited by claim 1, is formed within the substrate (2) instead of on an outer surface of the substrate (2). Furthermore, the probe terminal (8), which is interpreted by the Examiner as a disclosure of the probe pins recited by claim 1, does not contact the connection conductor (6). Instead, the probe terminal (8) contacts the electrode (3).

In contrast, the present invention, as recited by claim 1, contemplates a novel arrangement for an inspection probe wherein the wiring layers are mounted on an outer surface of the base member and the probe pins contacts the wiring layers.

Thus, Hagihara does not teach each and every element as recited by claim 1, from which claims 2-10 depend. Accordingly, the rejection of claims 1, 4, 6-7 and 9 under 35 U.S.C. § 102(b) based on Hagihara is overcome, and withdrawal thereof is respectfully requested.

The Examiner has further rejected claims 2-3, 5 and 8 under U.S.C. § 103(a) as allegedly unpatentable over Hagihara. The rejection is respectfully traversed.

Claim 1, from which claims 2-3, 5 and 8 depend, is discussed above. Hagihara is discussed above relative to claim 1. Since Hagihara does not disclose each and every element of claim 1, Hagihara fails to teach or fairly suggest the combination of features recited by claim 1.

Accordingly, the rejection of claims 2-3, 5 and 8 under U.S.C. § 103(a) based on Hagihara is overcome.


The Examiner has further rejected claim 10 under U.S.C. § 103(a) as allegedly unpatentable over Hagihara in view of U.S. Patent No. 5,974,662 to Eldridge et al., (hereinafter "Eldridge"). The rejection is respectfully traversed.

Claim 1, from which claims 2-3, 5 and 8 depend, is discussed above. Hagihara is discussed above relative to claim 1.

Eldridge is relied on to allegedly teach a metal layer made of a material having good contact property selected depending on a material of the external terminal electrodes of the semiconductor device. Eldridge is silent with respect to the distinguishing features of claim 1 over Hagihara. Thus, Eldridge does not overcome the underlying deficiencies of Hagihara relative to claim 1. Therefore, neither Hagihara nor Eldridge, taken alone or in combination, teaches or suggests the combination of features recited by claim 1. Accordingly, the rejection of claim 10 under U.S.C. § 103(a) based on the combination of Hagihara and Eldridge is overcome and withdrawal thereof is respectfully requested.

In view of the foregoing amendments and remarks, it is firmly believed that the subject application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

  
Paul J. Esatto, Jr.  
Registration No.: 30,749

Scully, Scott, Murphy & Presser, P.C.  
400 Garden City Plaza, Suite 300  
Garden City, New York 11530  
(516) 742-4343  
PJE/HC/tam